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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,587	11/16/2001	Craig Ullman	4247.43	7575

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EXAMINER

VU, VIET DUY

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/998,587

Applicant(s)
Ullman et al

Examiner
Viet Vu

Art Unit
2154



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 15, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-170 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-170 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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DETAILED ACTION

1. It is noted that the preliminary amendment filed 1/15/02 has not been entered because indicated page and line numbers are not matched with the current specification. New submission of the amendment with correct page and line numbers is required.

2. The preliminary amendment also includes an appendix consisting of a computer program listing of more than three hundred (300) lines. In accordance with 37 CFR 1.96(c), a computer program listing contained on more than three hundred (300) lines, must be submitted as a computer program listing appendix on compact disc conforming to the standards set forth in 37 CFR 1.96(c)(2) and must be appropriately referenced in the specification (see 37 CFR 1.77(b)(4)). Accordingly, applicant is required file a computer program listing appendix on compact disc in compliance with 37 CFR 1.96(c), and insert an appropriate reference to the newly added computer program listing appendix on compact disc at the beginning of the specification.

3. In claim 125, line 1, "claim 115 1" appears to be a typo error. Correction is required. For purpose of examining claim 125, the examiner assumes that claim 125 depends on claim 115.

Art Rejections:

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in--

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 4-35, 38-50, 52, 54-61, 64-111, 115, 117-130, 132-141, 143-156 and 158-170 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Palmer et al, hereafter Palmer, U.S. pat. No. 5,905,865.

Palmer discloses a system and method for providing media/broadcast programming and online services to user comprising:

a) a central server (70) for obtaining one or more addresses for identifying an online information source (see col 5, lines 44-47),

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- b) means for obtaining a schedule for indicating when to transmit the address to the user (col 5, lines 48-50),
- c) a first transmitter (90) for transmitting the program to user (col 5, lines 53-62),
- d) a second transmitter (70, 20) for transmitting the address directly to user (col 5, lines 63-66) or encoding the address and transmitting the encoded address to the user via a transmission medium including radio, satellite, cable, fiber optics, DVD, etc., (see col 8, lines 5-13),
- e) a web browser for extracting the address for automatically communicating with one of the online information providers (col 5, lines 32-34 and col 6, lines 10-13),
- f) a display for receiving information from the online service provider, e.g., advertisement, information on an artist, live chats and on-line ordering, for displaying at predetermined time during the program (col 6, line 47 - col 7, line 18).

Palmer also teaches using user profiles to select programming and/or content information (see col 7, lines 19-45).

Per claims 116, 131, 142 and 157, Palmer further teaches using a timer for controlling/switching display of specific information content in synchronism with the program (see col 6, lines 39-42).

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6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2-3, 36-37, 62-63 and 112-114 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer.

Per claims 2-3 and 62-63, Palmer's teachings are still applied as discussed in item 2 above. Palmer does not teach locating the first and second transmitters at a web-hosting site.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that Palmer's first and second transmitters can be implemented anywhere including at a web hosting site. However, implementing the first and second

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transmitters at a web-hosting site would have been motivated because it would have enabled the central office to coordinate the broadcast programming and online information sources more easily.

Per claims 36-37 and 112-114, Palmer does not teach storing addresses at the server in a link file to be downloaded to user.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to envision any conventional ways to store and transmit a group of addresses to user including individual transmission or in a link file. Sending a group of addresses together in a file would have been motivated because it would have reduced the transmission time.

9. Claims 51 and 53 are rejected under 35 U.S.C. § 103 as being unpatentable over Palmer and further in view of Dedrick, U.S. pat. No. 5,710,884.

Palmer's teachings are still applied as discussed in item 2 above. Palmer does not teach monitoring activities of each user during the program duration, e.g., user clicks. Such monitoring of user's computer and user's activity for marketing purpose is well known in the art as disclosed by Dedrick (see Dedrick's col 5, lines 17-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Palmer with Dedrick's

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teaching of data monitoring because it would have enabled the server to compile a more complete user profile for use by the advertisers.

Conclusion:

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Thursday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



**VIET D. VU
PRIMARY EXAMINER**

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5/2/02